REMARKS

Claims 1 through 20 are pending in the present case.

Claims 1 through 20 have been rejected.

This Amendment amends claims 1, 6, 7 and 20.

Claim Suggestions

Examiner has suggesting removing the repetition of the term "wherein" in claim 6. Applicant has so amended claim 6.

Claim Objections

Examiner has indicated the term "the expansion port" in claim 7 lacks antecedent basis. Applicant has amended claim 7 to remove the term.

Examiner has argued that claims 16 and 19 are indistinguishable from each other. However, claim 16 is dependent upon claim 14 and claim 19 is dependent on claim 17. The subject matter set out in claim 17, which is incorporated in claim 19 (but not in claim 16), render claim 19 distinguishable from claim 16.

Claim Rejections

Examiner has rejected claims 1 through 20 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Sage Instruments (925VST VoP Service Tester User's Manual Version 1.2) and USPN 6,603,569B1 (Johnson) and USPN 5,396,342 (Myer). Applicant has amended the claims to further clarify the subject matter Applicant views as the invention. Applicant respectfully traverses the rejection as to the claims as amended.

Below Applicant sets out subject matter in each of the independent claims not disclosed or suggested by the cited references. On the basis of this, Applicant believes all the claims are patentable over the cited references.

Page 8 of 21

Publication Date:

Examiner has cited Sage Instruments (925VST VoP Service Tester User's Manual Version 1.2) which has a copyright date of 2004. Normally this would not qualify as prior art of the present case under 35 U.S.C. § 102(b). However, in the Form PTO-892 that Examiner sent with the Office Action, Examiner has noted that information on Sage 925VST was available on www.sageinst.com via www.archive.org as of December 17, 2002. Applicant was unable to verify this. If Examiner maintains the rejection in the next Office Action, Applicant requests that Examiner document the existence of such a publication (at least providing a web address) so that Applicant can confirm the existence and substance of this disclosure.

In order to move the case forward, and because Applicant has no reason to doubt that Examiner will be able to provide confirmation of the existence of the cited reference, Applicant will respond to the rejection as if Examiner has documented disclosure or use of the Sage 925VST in such a way as to qualify it as prior art to the present invention.

Discussion of Independent Claim 1:

Claim 1 sets out a diagnostic tool. The diagnostic tool includes a fax test module, a display and a processor. The cited references, whether considered alone or in combination, do not disclose the functionality of the fax test module nor the processor.

Fax Test Module

The fax test module includes a telephone connector, a fax modem module, and a phone line emulator. Such a fax test module within a diagnostic tool is not disclosed or suggested by the cited art.

Sage discloses a voice over packet (VoP) tester. The VoP tester initiates VoP service qualification and maintenance tests from a customer premise or any two-wire or four-wire access point. See the Overview on page 4 of Sage.

Page 9 of 21

Examiner has conceded Sage does not disclose a phone line emulator. Johnson discloses line emulator used to connect to a fax machine. However, the line emulator is not within a tester, but within a fax interface unit used to connect a fax machine to the internet.

Examiner has asserted the following:

> It would have been obvious at the time the invention was made to one of ordinary skill in the art to provide the fax test system disclosed by Sage with the telephone line emulator disclosed by Johnson so that the device under test could be tested without connecting through a telephone line provided by a central office.

> See the Office Action dated July 11, 2007 at page 5, third full paragraph.

Applicant respectfully disagrees that it would be obvious to add a line emulator to Sage. As noted above, the VoP tester set out in Sage does not test fax machines per se. The VoP tester is a voice over packet tester. That means, it conducts telephony tests. See page 31 of Sage. While it has a fax test, the fax test is not to test the fax machine but to test fax transmissions over telephone lines.

Since the Sage is designed to detect fax transmissions from a fax machine over telephone lines, it would not be obvious to modify Sage to include a line emulator that could be connected directly to fax machine. In this case, this would remove the telephone connection between the Sage tester and the fax machine. Since the Sage tester is designed to test the telephone connection, removing the telephone connection would mean that the Sage tester has nothing test. Thus the modification to Sage suggested by Examiner would render Sage useless for it stated purpose—to conduct telephony tests. This would not be a modification that would be obvious to a person of ordinary skill in the art.

Page 10 of 21

The only reason to modify Sage, as suggested by Examiner would be to perform a piecemeal reconstruction based on hindsight form the teaching in Applicant's patent application. However, piecemeal reconstruction of prior art in the light of an applicant's disclosure is not a basis for a holding of obviousness under 35 U.S.C. § 103. *In re Kamm and Young,* 452 F.2d 1052, 172 U.S.P.Q. 298, 301 (C.C.P.A. 1972).

Applicant further notes that the consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that a claimed process should be carried out and would have reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be found in the prior art, not in the Appellant's disclosure. *In re Dow Chemical Col.,* 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988).

However, there is no suggestion in the prior art to modify the VoP tester in Sage to include a line emulator. Since use of a line emulator in the VoP tester in Sage would render the VoP tester useless for its stated purpose of conducting telephony tests, no person of ordinary art would expect such a modification to be a useful or successful one.

Processor

In claim 1, the processor causes menus to be shown on the display. The menus allow a user to select tests to be performed on a device under test. The tests include a send fax test, and a receive fax test. The menus list types of devices for which the diagnostic tool includes tests that are meant to determine whether a tested device from the types of devices is operating properly. The menus list at least one type of device that does not have fax capability and at least one type of device that does have fax capability. This is not disclosed or suggested by the cited art.

Examiner has argued that the menus are disclosed by Sage. This is incorrect. In claim1, the tests are meant to determine whether a tested device

Page 11 of 21

from the types of devices is operating properly. Thus the tests are meant to test a tested device. In Sage, telephony tests are conducted. While the telephony tests can use a responder, or even a fax machine, located at different phone numbers. *It is not the responder nor the fax machine that is being tested.* The thing being tested in Sage is the packet transmission over the telephone lines.

Thus any tests listed in any menu of Sage do not set out tests that are meant to determine whether a tested device from the types of devices is operating properly. Tests are only meant to test whether telephonic connections between a responder or a fax machine are operating properly. This does not disclose or suggest the menus set out in claim 1 of the present case.

Discussion of Independent Claim 3:

Claim 3 sets out a diagnostic tool. The diagnostic tool includes an expansion port, a fax test module, a display and a processor. The cited references, whether considered alone or in combination, do not disclose the functionality of the fax test module nor the processor.

The fax test module includes a telephone connector, a fax modem module, and a phone line emulator. Such a fax test module within a diagnostic tool is not disclosed or suggested by the cited art.

Sage discloses a voice over packet (VoP) tester. The VoP tester initiates VoP service qualification and maintenance tests from a customer premise or any two-wire or four-wire access point. See the Overview on page 4 of Sage.

Examiner has conceded Sage does not disclose a phone line emulator. Johnson discloses a line emulator used to connect to a fax machine. However, the line emulator is not within a tester, but within a fax interface unit used to connect a fax machine to the internet.

As discussed above, it would not be obvious to add a line emulator to Sage. As noted above, the VoP tester set out in Sage does not test fax machines per se.

Page 12 of 21

The VoP tester is a voice over packet tester. That means, it conducts telephony tests. See page 31 of Sage. While it has a fax test, the fax test is not to test the fax machine but to test fax transmissions over telephone lines.

Since the Sage is designed to detect fax transmissions from a fax machine over telephone lines, it would not be obvious to modify Sage to include a line emulator that could be connected directly to fax machine. In this case, this would remove the telephone connection between the Sage tester and the fax machine. Since the Sage tester is designed to test the telephone connection, removing the telephone connection would mean that the Sage tester has nothing test. Thus the modification to Sage suggested by Examiner would render Sage useless for it stated purpose—to conduct telephony tests. This would not be a modification that would be obvious to a person of ordinary skill in the art.

The only reason to modify Sage, as suggested by Examiner would be to perform a piecemeal reconstruction based on hindsight form the teaching in Applicant's patent application. However, piecemeal reconstruction of prior art in the light of an applicant's disclosure is not a basis for a holding of obviousness under 35 U.S.C. § 103.

Also, the consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that a claimed process should be carried out and would have reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be found in the prior art, not in the Appellant's disclosure. However, there is no suggestion in the prior art to modify the VoP tester in Sage to include a line emulator. Since use of a line emulator in the VoP tester in Sage would render the VoP tester useless for its stated purpose of conducting telephony tests, no person of ordinary art would expect such a modification to be a useful or successful one.

Discussion of Independent Claim 7:

Page 13 of 21

Claim 7 sets out a handheld diagnostic tool. The handheld diagnostic tool includes power circuitry, a fax test module, a display and a processor. The cited references, whether considered alone or in combination, do not disclose the functionality of the fax test module nor the processor.

Fax Test Module

The fax test module includes a telephone connector, a fax modem module, and a phone line emulator. Such a fax test module within a diagnostic tool is not disclosed or suggested by the cited art.

Sage discloses a voice over packet (VoP) tester. The VoP tester initiates VoP service qualification and maintenance tests from a customer premise or any two-wire or four-wire access point. See the Overview on page 4 of Sage.

Examiner has conceded Sage does not disclose a phone line emulator. Johnson discloses a line emulator used to connect to a fax machine. However, the line emulator is not within a tester, but within a fax interface unit used to connect a fax machine to the internet.

As discussed above, it would not be obvious to add a line emulator to Sage. As noted above, the VoP tester set out in Sage does not test fax machines per se. The VoP tester is a voice over packet tester. That means, it conducts telephony tests. See page 31 of Sage. While it has a fax test, the fax test is not to test the fax machine but to test fax transmissions over telephone lines.

Since the Sage is designed to detect fax transmissions from a fax machine over telephone lines, it would not be obvious to modify Sage to include a line emulator that could be connected directly to fax machine. In this case, this would remove the telephone connection between the Sage tester and the fax machine. Since the Sage tester is designed to test the telephone connection, removing the telephone connection would mean that the Sage tester has nothing test. Thus the modification to Sage suggested by Examiner would

Page 14 of 21

render Sage useless for it stated purpose—to conduct telephony tests. This would not be a modification that would be obvious to a person of ordinary skill in the art.

The only reason to modify Sage, as suggested by Examiner would be to perform a piecemeal reconstruction based on hindsight form the teaching in Applicant's patent application. However, piecemeal reconstruction of prior art in the light of an applicant's disclosure is not a basis for a holding of obviousness under 35 U.S.C. § 103.

Also, the consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that a claimed process should be carried out and would have reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be found in the prior art, not in the Appellant's disclosure. However, there is no suggestion in the prior art to modify the VoP tester in Sage to include a line emulator. Since use of a line emulator in the VoP tester in Sage would render the VoP tester useless for its stated purpose of conducting telephony tests, no person of ordinary art would expect such a modification to be a useful or successful one.

Processor

In claim 7, the processor causes menus to be shown on the display. The menus allow a user to select tests to be performed on a device under test. The tests are designed to determine proper operation of the device under test. This is not disclosed or suggested by the cited art.

Examiner has argued that the menus are disclosed by Sage. This is incorrect. In claim 7, the tests are designed to determine proper operation of the device under test. In Sage, telephony tests are conducted. While the telephony tests can use a responder, or even a fax machine, located at different phone numbers. *It is not the responder nor the fax machine that is being tested.*

Page 15 of 21

The thing being tested in Sage is the packet transmission over the telephone lines.

Thus any tests listed in any menu of Sage do not set out tests that are designed to determine proper operation of a fax machine. Tests are only meant to test whether telephonic connections between a responder or a fax machine are operating properly. This does not disclose or suggest the menus set out in claim 7 of the present case.

Discussion of Independent Claim 11:

Claim 11 sets out a method for testing a device under test (DUT). The method includes the step of sending a fax from the diagnostic tool to the DUT, where the diagnostic device, over a cable, emulates a phone line to the DUT. This is not disclosed or suggested by the cited references. The cited references, whether considered alone or in combination, do not disclose the functionality of the fax test module nor the processor.

Examiner has conceded Sage does not disclose a phone line emulator. Johnson discloses a line emulator used to connect to a fax machine. However, the line emulator is not within a tester, but within a fax interface unit used to connect a fax machine to the internet.

As discussed above, it would not be obvious to add a line emulator to Sage. As noted above, the VoP tester set out in Sage does not test fax machines per se. The VoP tester is a voice over packet tester. That means, it conducts telephony tests. See page 31 of Sage. While it has a fax test, the fax test is not to test the fax machine but to test fax transmissions over telephone lines.

Since the Sage is designed to detect fax transmissions from a fax machine over telephone lines, it would not be obvious to modify Sage to include a line emulator that could be connected directly to fax machine. In this case,

Page 16 of 21

this would remove the telephone connection between the Sage tester and the fax machine. Since the Sage tester is designed to test the telephone connection, removing the telephone connection would mean that the Sage tester has nothing test. Thus the modification to Sage suggested by Examiner would render Sage useless for it stated purpose—to conduct telephony tests. This would not be a modification that would be obvious to a person of ordinary skill in the art.

The only reason to modify Sage, as suggested by Examiner would be to perform a piecemeal reconstruction based on hindsight form the teaching in Applicant's patent application. However, piecemeal reconstruction of prior art in the light of an applicant's disclosure is not a basis for a holding of obviousness under 35 U.S.C. § 103.

Also, the consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that a claimed process should be carried out and would have reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be found in the prior art, not in the Appellant's disclosure. However, there is no suggestion in the prior art to modify the VoP tester in Sage to include a line emulator. Since use of a line emulator in the VoP tester in Sage would render the VoP tester useless for its stated purpose of conducting telephony tests, no person of ordinary art would expect such a modification to be a useful or successful one.

Discussion of Independent Claim 14:

Claim 14 sets out a method for testing a device under test (DUT). The method includes the step of sending a fax from the DUT to the diagnostic too, where the diagnostic device, over a cable, emulates a phone line to the DUT. This is not disclosed or suggested by the cited references. The cited references, whether considered alone or in combination, do not disclose the functionality of the fax test module nor the processor.

Page 17 of 21

Examiner has conceded Sage does not disclose a phone line emulator. Johnson discloses a line emulator used to connect to a fax machine. However, the line emulator is not within a tester, but within a fax interface unit used to connect a fax machine to the internet.

As discussed above, it would not be obvious to add a line emulator to Sage. As noted above, the VoP tester set out in Sage does not test fax machines per se. The VoP tester is a voice over packet tester. That means, it conducts telephony tests. See page 31 of Sage. While it has a fax test, the fax test is not to test the fax machine but to test fax transmissions over telephone lines.

Since the Sage is designed to detect fax transmissions from a fax machine over telephone lines, it would not be obvious to modify Sage to include a line emulator that could be connected directly to fax machine. In this case, this would remove the telephone connection between the Sage tester and the fax machine. Since the Sage tester is designed to test the telephone connection, removing the telephone connection would mean that the Sage tester has nothing test. Thus the modification to Sage suggested by Examiner would render Sage useless for it stated purpose—to conduct telephony tests. This would not be a modification that would be obvious to a person of ordinary skill in the art.

The only reason to modify Sage, as suggested by Examiner would be to perform a piecemeal reconstruction based on hindsight form the teaching in Applicant's patent application. However, piecemeal reconstruction of prior art in the light of an applicant's disclosure is not a basis for a holding of obviousness under 35 U.S.C. § 103.

Also, the consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that a claimed process should be carried out and would have reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the

Page 18 of 21

expectation of success must be found in the prior art, not in the Appellant's disclosure. However, there is no suggestion in the prior art to modify the VoP tester in Sage to include a line emulator. Since use of a line emulator in the VoP tester in Sage would render the VoP tester useless for its stated purpose of conducting telephony tests, no person of ordinary art would expect such a modification to be a useful or successful one.

Discussion of Independent Claim 20:

Claim 20 sets out a diagnostic tool. The diagnostic tool includes a module means for sending and receiving fax. The module means includes an emulator means for emulating a phone line. The cited references, whether considered alone or in combination, do not disclose the functionality of the module means within a diagnostic tester.

Sage discloses a voice over packet (VoP) tester. The VoP tester initiates VoP service qualification and maintenance tests from a customer premise or any two-wire or four-wire access point. See the Overview on page 4 of Sage.

Examiner has conceded Sage does not disclose a phone emulator means. Johnson discloses an emulator means used to connect to a fax machine. However, the emulator means is not within a tester, but within a fax interface unit used to connect a fax machine to the internet.

As discussed above, it would not be obvious to add an emulator means to Sage. As noted above, the VoP tester set out in Sage does not test fax machines per se. The VoP tester is a voice over packet tester. That means, it conducts telephony tests. See page 31 of Sage. While it has a fax test, the fax test is not to test the fax machine but to test fax transmissions over telephone lines.

Since the Sage is designed to detect fax transmissions from a fax machine over telephone lines, it would not be obvious to modify Sage to include an emulator means that could be connected directly to fax machine. In this case, this would remove the telephone connection between the Sage tester and

Page 19 of 21

the fax machine. Since the Sage tester is designed to test the telephone connection, removing the telephone connection would mean that the Sage tester has nothing test. Thus the modification to Sage suggested by Examiner would render Sage useless for it stated purpose—to conduct telephony tests. This would not be a modification that would be obvious to a person of ordinary skill in the art.

The only reason to modify Sage, as suggested by Examiner would be to perform a piecemeal reconstruction based on hindsight form the teaching in Applicant's patent application. However, piecemeal reconstruction of prior art in the light of an applicant's disclosure is not a basis for a holding of obviousness under 35 U.S.C. §.103.

Also, the consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that a claimed process should be carried out and would have reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be found in the prior art, not in the Appellant's disclosure. However, there is no suggestion in the prior art to modify the VoP tester in Sage to include an emulator means. Since use of an emulator means in the VoP tester in Sage would render the VoP tester useless for its stated purpose of conducting telephony tests, no person of ordinary art would expect such a modification to be a useful or successful one.

CONCLUSION

Applicant believes this Amendment has placed the present case in condition for allowance and favorable action is respectfully requested.

Respectfully submitted,

DAVID G. HILLE
KENNETH L. BUSWELL

By _____
Douglas L. Weller
Reg. No. 30,506

October 4, 2007
Santa Clara, California
(408) 985-0642

Page 21 of 21